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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,465	01/06/2004	Charles Widman	33895.4	3376

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EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,465

Applicant(s)

WIDMAN ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-4, 6 and 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 4, 11 and 12 the limitation of "wherein the clamping device is removably adhered to the sheet" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although it is clear that the clamp device of the applicants claimed invention is secured to the sheet through a variety of ways including adhesives there is simply no disclosure of the limitation of a removable relationship between the two anywhere in applicants original disclosure.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson '529 in view of Woods '901, Chua '299 and Covell '412. Dickson discloses a educational bookmark that can be used with erasable markings containing most of the elements of the claims including a reusable sheet having two sides and a top edge (sheet 10, col. 2, lines 63-67) as required by claims 1, 4, 11 and 12, a clamping device (clip 26) as required by claims 1, 4, 11 and 12, an erasable writing instrument (10) as required by claims 1, 4, 11 and 12. A top edge having an adhesive coating, as required by claims 2, 5, 11 and 12, is described in col. 4, lines 2-5 where it should be noted that the nature of adhesives is that any two portions held together by such fastening means are considered removable since fastening properties of adhesives can be broken. The use of transparent vinyl and a marking pen containing water soluble ink, as required by claims 4 and 12, is described in col. 3, lines 16-18 and lines 22-26.

Although Dickson discloses most of the elements of the claims, as stated above, and further including a teaching that his device can be manufactured from a variety of materials including a polyester material (col. 3, lines 31-41), the reference fails to explicitly teach a sheet being transparent as required by claims 1, 4, 11 and 12 and composed of a non-top coated polyester film as required by claims 1, 11, a clamping

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device capable of securing the sheet to a document to be marked as required by claim 1, 4, 11 and 12, an erasable writing instrument being a dry erase marking pen as required by claims 1, 11 and an eraser as required by claims 3, 4, 11. However, Chua discloses that it is known to manufacture erasable bookmarks from a transparent material (including polyester) in page 1, paragraph [0010] and [0012]. While Woods teaches that it is known to utilize a non-top coated material as an erasable surface (col. 2, line 42), which can be packaged together with a dry-erase marker (16) and eraser (20). Covell discloses a bookmark and holder, like that of Dickson, which further teaches structure which allows it to be capable of being clamped to a document/book (figures 1-2 and lines 85-90). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention, to manufacture the device of Dickson from a transparent non-top coated polyester material packaged with a dry erase marking pen and eraser for the purpose of providing a bookmark which limits the amount of obstructed text while at the same time providing a durable, simple, easy to use surface which does not wipe off readily with ordinary handling but will wipe off easily with the eraser. It would have further been obvious to utilize the structure of Covell in the clip of Dickson for the purpose of providing a bookmark that can be clipped to a book/document it is being used with, especially since Dickson clearly states that a variety of configurations of the clip portion of his device is envisioned with his invention (col. 4, lines 8-9).

Response to Arguments

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Applicant's arguments filed September 10th, 2004 have been fully considered but they are not persuasive. Applicants argue that there is no motivation to combine the references of Dickson, Covell, Chua and Woods. In support of this argument applicants state that their device is not directed to a bookmark and that none of the mentioned references cite one another as prior art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dickson discloses a markable/erasable bookmark which holds a marking instrument Chua goes a step further to teach manufacturing a markable bookmark from a transparent material of a polyester nature and clearly provides the motivation for manufacturing the book mark from a transparent material in order to limit the amount of obstructed text (see Chua page 1, lines 6-7 of paragraph 0003). In turn Covell also discloses a bookmark which has a clip/holder portion (8) for holding a writing implement (much like Dickson), but goes a step further by teaching that is advantageous to provide such a bookmark in the form of a clamping device for the purpose of providing a bookmark that can be clipped to a book/document it is being used with (page 1, lines 85-90) therefore the combination of the two references would have been obvious especially since Dickson clearly states that a variety of

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configurations of the clip portion of his device is envisioned with his invention (col. 4, lines 8-9). The Woods reference is relied upon by the examiner to teach that it is known to utilize a non-top coated material as an erasable surface (col. 2, line 42), which can be packaged together with a dry-erase marker (16) and eraser (20) where the motivation for manufacturing of such a surface from the non-top coated material packaged together with a dry-erase marker and eraser can be found in col. 1, lines 28-30 where it clearly states that such a surface is not easily wiped of with ordinary handling but will wipe off easily with the eraser. Therefore the motivation to combine the references is clearly stated in the prior art of record and one having ordinary skill in the art would have most certainly looked to all of the above references and their teaching at the time of the applicants claimed invention as stated above and in the previous office action.

Furthermore, the examiner respectfully reminds the applicants that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to applicants arguments that the clip device is not the clamping device of the applicants invention it is pointed out that the clip of Dickson functions to clamp a writing implement in its respective tubular section and therefore is a sort of

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clamping device, however the examiner does point out that the clip of Dickson is not necessarily meant to/capable of functioning as securing the sheet to a document to be marked, in which case the examiner has introduced the Covell reference as teaching such structure needed for the above functionality (see above rejection and arguments).

With respect to applicants arguments the Chua does not disclose a non-top coated polyester for ease of marking and erasing, the examiner points out that (as stated above and in the previous office action) Chua is relied upon to teach that it is known to manufacture a writable bookmark from a transparent material including polyester, while Woods is relied upon to teach that it is known to manufacture a writable surface from a non-top coated polyester.

With respect to applicants arguments regarding Woods and the lack of transparent properties it is pointed out that Woods is silent as to the transparent properties of his labels and applicants statement that Woods teaches away from transparency is purely conjecture on the part of the applicants as there is absolutely no such teaching in Woods. Furthermore it is pointed out that Chua is relied upon to teach transparent properties and their benefits with a writable bookmark.

Regarding applicants arguments with respect to Covell and that it only teaches a clamp, the examiner points out that Covell teaches a clamp and not a transparent sheet attached thereto, the examiner points that Covell is not relied upon to teach a transparent sheet. The teachings of Covell are stated above and in the previous office action.

The combination of references, as stated above, has proper motivation in the art and discloses every limitation as claimed and is capable of fulfilling each and every function claimed by the applicants. Therefore the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

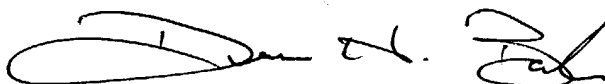
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-273-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

A handwritten signature in black ink, appearing to read "Derris H. Banks", with a large, stylized initial "D" and a flourish at the end.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700